

REMARKS

Claims 1-19 are pending in the application and all of the claims have been rejected. The Applicant has only amended claim 10.

The Applicant has carefully considered the Office Action mailed on April 6, 2009 and responds to the specific issues raised by the Examiner as follows:

Information Disclosure Statement

In the previous Office Action mailed on July 1, 2008, the Examiner stated that the Information Disclosure Statement (“IDS”) submitted by the Applicant on December 17, 2007 was placed in the application file, but the information referred to therein was not considered because copies of foreign patent documents had not been submitted. The Applicant argued that he was not required to submit copies of these documents under 37 CFR 1.98(c) and requested that the Examiner withdraw his objection and that the IDS be considered. The Examiner did not respond to this request in the Office Action mailed on April 6, 2009. Accordingly, the Applicant renews his request to have the Examiner’s objection withdrawn and the IDS considered.

Rejection Under 35 U.S.C. 102

Lyen

Claims 1, 2, 6, 13, 15 and 17 have been rejected as anticipated by U.S. Patent No. 6,227,572 to Lyen (“Lyen”), which discloses tactile identifying indicia for banknotes and documents that are formed by embossments. The security device includes a sheet material with at least one embossment forming indicia with one of the surfaces defining a cavity in the area of

the embossment. A layer of reinforcing material is provided on the surface at least in the area of the embossment. Lyen discloses at col. 2, lines 60-66 that:

For each embossment 20 the bottom surface of the sheet material in (at least) the area comprising the cavity 25 is provided with a layer of a fluid reinforcing material 40 which, when dried and/or cured, reinforces the cavity 25. This layer is **applied to the surface of the sheet material by coating the surface** and some of the reinforcing material is absorbed into the sheet material.

Emphasis added.

FIG. 3 of Lyen (reproduced below) shows how the layer of reinforcing material 40 covers the entire surface of the sheet material 30 and all of the cavities 25 formed by the embossments 20. There is no teaching or suggestion in Lyen of an “opening” in layer 40 that would allow the surface of the sheet material 30 to be felt. Instead, Lyen teaches that the layer

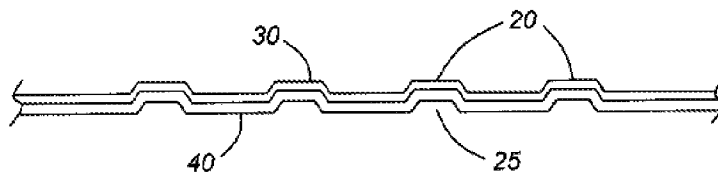


FIG. 3

of reinforcing material 40 “is applied to the surface of the sheet material by coating the surface.”

One of ordinary skill in the art would understand that such a coating process would not be used if Lyen intended to provide openings in the layer at specific locations corresponding to the locations of the embossments.

The Office Action states at page 3 that Lyen teaches a security document 10:

wherein the at least one surface region is formed by a film portion which is of a corresponding configuration and which is applied to the substrate and which comprises a material different from the substrate and which has **openings through which the surface of the substrate can be felt** (Column 2, Lines 60 –

64; Column 3, Lines 3 – 14, 20 – 30; Figure 3, item 40; Figure 2, item 20 shows gaps in between the embossments and therefore **two areas where the film exists and in between the two areas the substrate exists without coating 40**).

Emphasis added.

The Applicant respectfully disagrees with the finding that Lyen teaches “a film portion...which has openings through which the surface of the substrate can be felt” and submits that such openings are not shown in Figures 2 and 3 of Lyen. Contrary to the Examiner’s finding, Figure 3 of Lyen clearly shows that the “layer of a fluid reinforcing material 40” covers the entire surface of the sheet material. Figure 3 does not show “gaps in between the embossments” or “two areas where the film exists and in between the two areas the substrate exists without coating 40” as the Office Action states.

The Office Action states that “Figure 2, item 20 shows gaps in between the embossments.” However, there is no support in the specification or any of the figures of Lyen that there are “gaps” or any other type of openings in the film portion 40 in between the embossments 20. Figure 3 of Lyen (see above) is a sectional view of Figure 2 and it clearly shows that there are no gaps in between the embossments 20 in either sheet material layer 30 or reinforcement material layer 40. Lyen teaches that layer 30 is a continuous layer of sheet material 30 with embossments 20 and that layer 40, on the opposite surface of sheet material 30 from the raised embossments 20, is a continuous layer of “a reinforcement material 40.” See col. 2, line 62. Figure 3 clearly shows that there are no “gaps” in layer 40 through which the surface of the sheet material 30 could be contacted as required by the Applicant’s claims.

Lyens fails to teach the opening in the film layer through which the surface of the substrate can be felt as required by independent claim 1 and dependent claims 2, 6, 13, 15 and 17. Therefore, Lyens does not anticipate these claims. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 1, 2 6, 13, 15 and 17 as anticipated by Lyens.

Herrmann

Claims 1-19 have also been rejected as anticipated by U.S. Patent Application Publication No. 2002/00303360 to Herrmann et al. (“Herrmann”), which discloses a value-bearing document with a window that can be provided with other security features.

Claims 1-9 and 13-19 require an opening in the film portion of the security element that allows the substrate to be felt. There is no teaching or suggestion in Herrmann of a paper substrate covered by a film coating with openings through which the surface of the paper substrate can be felt.

The Office Action states at page 5, line 21 to page 6, line 13 that:

wherein the at least one surface region is formed by a film portion (Paragraph 0031, Lines 7-8 teach it is a continuous element on the substrate and therefore it can be a film or Paragraph 0034, Lines 1-2 teaches that the portion is recessed and one running there [sic] finger across the portion can feel the dip and raising on the substrate and Paragraph 0037 teaches of the foil and element 13 wherein more than one element 13 can be provided) **which is of a corresponding configuration and which is applied to the substrate and which comprises a material different from the substrate and which has openings through which the surface of the substrate can be felt** (Figure 1, Item 3 shows 4 portions with substrate portions in between; furthermore the substrate is paper and a reflective material will not be made of paper or Paragraph 0037 teaches that the foil capable

of various materials can also be used to create the security element of 13 which a foil will [sic] different in feeling from a substrate of paper and running ones finger between portions 13 will have them feel the substrate; furthermore paragraph 0037 teaches that various coatings can be used and they will also have a different feeling to paper substrates).

(Emphasis added.)

The Examiner has found that Herrmann teaches a security document with a surface region “formed by a film portion . . . which is applied to the substrate . . . and which has openings through which the surface of the substrate can be felt.” The Applicant respectfully disagrees with the finding that Herrmann discloses a film portion with openings through which the paper substrate can be felt. As set forth below, the portions of Herrmann cited by the Examiner clearly do not support this finding.

1. The Examiner states that: “Figure 1, Item 3 shows 4 portions with substrate portions in between; furthermore the substrate is paper and a reflective material will not be made of paper.” Herrmann does not disclose that the substrate in between the four portions of Item 3 can be contacted through an opening in a film layer. Herrmann discloses in Paragraph 0032 that: “cover foil 5 is fixed over the full area on the one surface 6 of the carrier 2.” Herrmann neither teaches nor suggests that the coil 5 has openings through which the paper substrate can be contacted. Moreover, if item 3 is covered with a “reflective material” such as a film layer as the Examiner implies, there is no teaching or suggestion in Herrmann that the “reflective material” only covers item 3 and not the entire substrate.

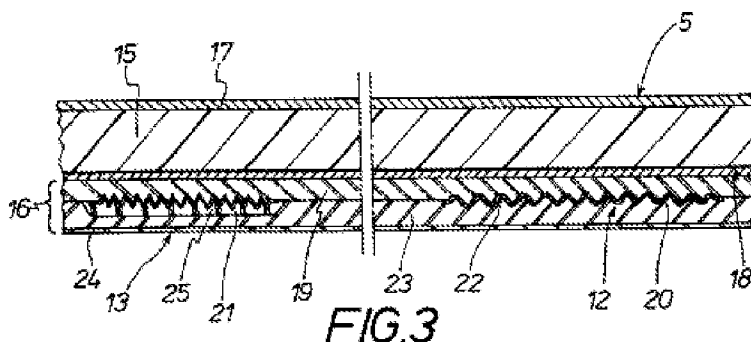
2. The Examiner states that: “Paragraph 0037 teaches that the foil capable of various materials can also be used to create the security element of 13 which a foil will [sic] different in feeling from a substrate of paper and running ones finger between portions 13 will have them feel the substrate.” First, Herrmann does not teach that security feature 13 has portions capable of running one’s fingers between. Second, this finding is a misinterpretation of Paragraph 0037 of Herrmann, which states:

In addition, as shown in FIG. 1, outside the region corresponding to the window-like opening **the cover foil may be provided with at least one additional security feature 13** which is based for example on optical effects, which security feature 13 can also be of the most widely varying kinds and natures in dependence on the material of the cover foil, any coating thereon, etc.

(Emphasis added.)

Herrmann clearly teaches that the security feature 13 is provided as part of the cover foil 5.

Moreover, FIG. 3 of Herrmann, which is reproduced below, clearly shows that the security feature 13 is inside the carrier foil 5—opposite the outer surface—and is located on the side of the cover foil 5 that contacts the paper substrate (not shown). The security feature 13 is “buried”



in the foil 5 and cannot be felt by running one’s fingers over the surface of the cover foil 5. One skilled in the art would not find it possible to run “ones finger between portions 13 [to] feel the

substrate.” Thus, the security feature 13 in Herrmann is constructed so that it is protected by other layers of the cover foil 5 structure and a person cannot feel the substrate “between portions 13” as the examiner has found.

3. The Examiner states that: “furthermore paragraph 0037 teaches that various coatings can be used and they will also have a different feeling to paper substrates.” This statement may be true but it does not support the Examiner’s finding that the coatings have openings through which the substrate can be felt. Herrmann discloses in Paragraph 0037 that: “security feature 13 can also be of the most widely varying kinds and natures in dependence on the material of the cover foil, any coating thereon, etc.” One of ordinary skill in the art would interpret this statement to mean that a coating may be applied to the cover foil. There is no teaching or suggestion in Paragraph 0037 of Herrmann that the coating on the cover foil has any openings and, even if the coating did have an opening, it would only allow one to feel the surface of the cover foil and not the substrate.

Thus, the portions of Herrmann cited by the Examiner as teaching an opening in the film or cover foil have been misinterpreted by the Examiner. There is no teaching or suggestion in Herrmann of a paper substrate with “at least one surface region formed by a film portion...which has openings through which the surface of the substrate can be felt” as required by claim 1.

Claim 2 was rejected based on a finding that Paragraph 0032, Lines 7-8 of Herrmann teaches that: “the film is reflective and embossed.” Claim 2 requires that: “the substrate and the film portion are formed by different kinds of film.” “Reflective and embossed” are two

characteristics of a single film and not two different kinds of film as the Examiner has found.

Paragraph 0032 of Herrmann neither teaches nor suggests that the substrate and the film portion are formed by different kinds of film as claim 2 requires.

Claim 3 was rejected based on a finding that Paragraph 0037 of Herrmann discloses that” “the substrate and the film portion are formed by papers with respective markedly different surface properties which can be determined by means of the human sense of touch.” The Examiner states at the top of page 7 of the Office Action that Paragraph 0037: “teaches that the foil for [security feature] 13 can be of various materials and that on the surface of the foil there is an optical effect which can be made in various ways.” This finding is a misinterpretation of Paragraph 0037 of Herrmann, which states:

In addition, as shown in FIG. 1, outside the region corresponding to the window-like opening the cover foil may be provided with at least one additional security feature 13 which is based for example on optical effects, **which security feature 13 can also be of the most widely varying kinds and natures** in dependence on the material of the cover foil, any coating thereon, etc.

(Emphasis added.)

Paragraph 0037 of Herrmann teaches that the security feature 13 can be of the “most widely varying kinds and natures” and that the cover foil can be coated. However, Paragraph 0037 does not teach “that on the surface of the foil there is an optical effect” as the Examiner has found. Nor does Paragraph 0037 teach that the cover foil is paper as the Examiner has found. Moreover, there is no teaching or suggestion that the cover foil or the coating on the cover foil has an opening through which the surface of the paper substrate can be felt.

Accordingly, since Herrmann does not teach a paper substrate covered by a foil portion with an opening through which the surface of the substrate can be felt, claims 1-9 and 13-19 are not anticipated by Herrmann and the Applicant respectfully requests that the rejections be withdrawn.

Independent claim 10 and dependent claims 11 and 12 have been rejected as anticipated by Herrmann. Claim 10 requires a substrate with a window-like opening that can be determined by means of the human sense of touch and a film fixed on a surface of the substrate that covers the opening. The surface natures of the substrate and the film are markedly different in a manner that can be determined by means of the human sense of touch. Claim 10 also requires that:

- a) the film projects beyond the opening of the substrate and in its projecting region is provided with at least one aperture through which the surface of the substrate can be felt and/or
- b) the film is three-dimensionally embossed at least region-wise to produce a particular structure, and/or
- c) the film is provided at least in its region covering the opening with a perforation in the form of a pattern which can be easily felt.

Claim 10 has been amended to delete the requirement that “the film is provided in a region-wise manner with a coating, for example printing thereon.” The other required features of claim 10 (a-c as listed above) are not disclosed in Herrmann. Herrmann does not disclose (a) a “film [that] projects beyond the opening of the substrate and in its projecting region is provided with at least one aperture through which the surface of the substrate can be felt.” As discussed in

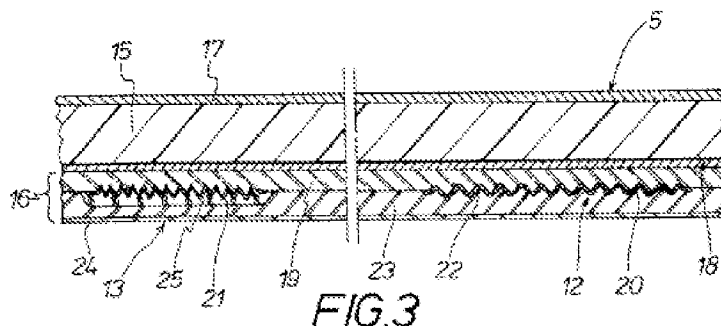
detail with respect to claims 1-9 and 13-19, Herrmann does not disclose a film layer with an opening through which the surface of the substrate can be contacted.

Herrmann does not disclose (b) a “film [that] is three-dimensionally embossed at least region-wise to produce a particular structure.” The Applicant’s specification discloses at page 8, line 30 to page 9, line 2 that:

In the present case, **at its surface 5 remote from the substrate**, the film strip 2 is provided with an **embossing or other structure 6 which produces a corresponding roughness** and which for example, as indicated in FIG. 1, can be in the form of corrugation lines extending in the longitudinal direction of the security document.

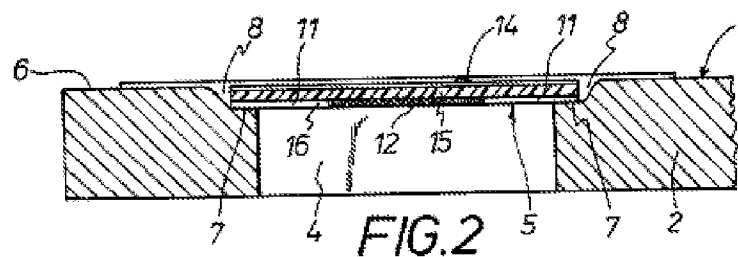
(Emphasis added.)

The “surface 5 remote from the substrate” is the exposed surface that can easily be felt using the human sense of touch. In contrast, the embossed structures 12, 13 taught by Herrmann are not on the surface as shown in FIG. 3 (reproduced below) but are formed in the internal layers of the cover foil 5. One skilled in the art would understand that the embossed layers



taught by Herrmann cannot be felt using the human sense of touch because FIG. 3 in Herrmann shows that the surface of the cover foil 5 is substantially flat.

Herrmann does not disclose (c) a “film [that] is provided at least in its region covering the opening with a perforation in the form of a pattern which can be easily felt.” There is no teaching or suggestion in Herrmann that the portion of the cover foil 5 (see FIG. 2 reproduced below) that covers the opening 4 in the substrate 2 has perforations in the form of a pattern or any perforations whatsoever. Accordingly, there is no teaching or suggestion in Herrmann of



a film or cover foil with perforations that anticipates paragraph (c) of claim 10.

For the reasons set forth above, Herrmann does not anticipate claim 10, nor does Herrmann anticipate claims 11 and 12 which depend on claim 10. Therefore, the Applicant respectfully requests that the rejection of claims 10-12 be withdrawn.

Conclusion

The Applicant respectfully submits that the arguments made herein have distinguished the cited references from the present invention and requests early allowance of the claims. If the Examiner has any questions or comments relating to this response, the Examiner is respectfully invited to contact Applicant's attorney at the telephone number provided below.

Respectfully submitted,

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